Remarks

This Amendment is responsive to the Office Action mailed October 26, 2000 (Paper No. 11), which Office Action was made final. Entry of this Amendment and reconsideration of the subject application in view thereof are respectfully requested.

Claims

Claims 25-35 and 37-47 were pending. Claims 25-35 and 37-47 stand or stood rejected.

Claims 34-35 and 43 have been canceled without prejudice or disclaimer of the subject matter therein. Moreover, Applicants reserve the right to prosecute, in one or more patent applications, the canceled claims, the claims to non-elected inventions, the claims as originally filed, and any other claims supported by the specification.

Claims 25, 30, 33, 37, 39, 42, 44 and 47 have been amended to more particularly and distinctly define the invention. No new matter is added.

It is believed that entry of this Amendment will not require payment of any additional claim fees. Notwithstanding, Applicants hereby authorize the Commissioner to charge any additional claim fees required by entry of this Amendment to Deposit Account No. 50-0258.

Support

Support for the amendments to the claims is either apparent or as set forth herein. Specifically, support for the recitation "wherein the first polynucleotide sequence is not genomic DNA" may be found in the specification at, for example, page 3, lines 24-28. No new matter is added.

Claim Rejections under 35 U.S.C. § 101

Claims 25-35 and 37-47 stand or stood rejected under 35 U.S.C. § 101 as lacking patentable utility. Specifically, the Examiner asserts that

> Applicant argues that the claimed polynucleotides and polypeptides have utility as diagnostic reagents for use in the detection of *Streptococcus pneumoniae*. Applicants further argue that the claimed polynucleotides could be used to identify bacterial contamination wherein the bacteriological tests are indicative and not dispositive. These argument are not found persuasive because

> the recited uses are of a general utility and not specific and substantial or well established and because the specification teaches the claimed polynucleotides may be obtained from other organisms (page 11, lines 27-30). Therefore the claimed polynucleotides do not have a specific and substantial asserted utility or well established utility for the detection of *Streptococcus pneumonia*.

Applicants maintain their traversal to this rejection on the bases asserted in their response to Paper No. 9. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

Claims 25-34 and 37-47 stand or stood rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner asserts that

> Applicant argues that because the claimed nucleic acids would typically be replicated in vectors comprising the necessary regulatory elements which are not described in the specification and therefore the subject matter not taught in the specification falls within what is conventional and well-known in the art. This argument is not found persuasive because the claims are written so broadly as to encompass a very large genus of sequences. The recitation "an isolated polynucleotide comprising a first polynucleotide sequence .....wherein the first polynucleotide sequence is at least 95% identical to SEQ ID NO:1" encompasses a large genus of polynucleotides including genes and the specification does not teach the claimed genes or a representative number of the claimed species.
>
> Applicant further argues Examples 8 and 11 set forth in the Written Description Guidelines teach examples of allowable claims having equivalent scope to the instant claims. This argument is not found persuasive because Examples 8 and 11 and the instant claims are different in scope. Specifically, in Example 8 the claim is drawn to an isolated nucleic acid sequence, SEQ ID NO:2 and the specification teaches that SEQ ID NO:2 consists of the complete ORF. The scope of Example 8 is limited to nucleic acid sequences comprising SEQ ID NO:2 which is taught in the specification while the scope of the instant claims comprises a large genus of sequences not taught in the specification. Claim 1 of Example 11 is drawn to an isolated cDNA that encodes protein X (SEQ ID NO:2) and the specification teaches one species of the claimed cDNA however, the Guidelines teach that one of skill could apply the genetic code to envision the claimed genus. The

> Guidelines teach that an adequate written description of Claim 1 is provided in the specification but Claims 2 and 3 being drawn to allelic variants of SEQ ID NO:2 lack an adequate description. The scope of Example 11, Claim 1 is limited to a cDNA that encodes SEQ ID NO:2 which is taught in the specification while the scope of the instant claims being drawn to a large genus of sequences is much broader than either Example 8 or 11.

Without conceding the validity of this rejection, Applicants have elected to present the invention in different terms, which terms obviate the asserted bases for this rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

FEE DEFICIENCY

☒ If an extension of time is deemed required for consideration of this paper, please consider this paper to comprise a petition for such an extension of time; The Commissioner is hereby authorized to charge the fee for any such extension to Deposit Account No. 50-0258.

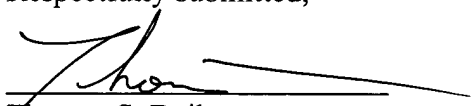
and/or

☒ If any additional fee is required for consideration of this paper, please charge Account No. 50-0258.

Closing Remarks

Applicants thank the Examiner for the Office Action and believe this response to be a full and complete response to such Office Action. Accordingly, favorable reconsideration in view of this response and allowance of the pending claims are earnestly solicited.

Respectfully submitted,



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